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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,377	02/13/2002	Andreas Berginger	225/50412	8001

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EXAMINER

WONG, EDNA

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 09/05/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,377

Applicant(s)

BERGINGER ET AL.

Examiner

Edna Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on March 23, 1999. It is noted, however, that applicant has not filed a certified copy of the 199 12 896.0 application as required by 35 U.S.C. 119(b).

Specification

The disclosure is objected to because of the following informalities:

page 5, line 18, "CR-Ni" should be amended to -- Cr-Ni --.

page 8, line 17, there is no "Figure 3".

page 9, line 36, there is no "Figure 3".

page 10, line 9, there is no "Figure 5".

page 10, line 22, there is no "Figure 6".

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to

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determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims **17, 19 and 26** are objected to because of the following informalities:

Claim 17

line 2, it is suggested that the word "deposited" be amended to the word -- electrodeposited --.

line 7, it is suggested that the word "depositing" be amended to the word -- electrodepositing --.

line 11, it is suggested that the words "direct and alternating voltage does" be amended to the words -- the direct and alternating voltages do --.

Claim 19

line 3, it is suggested that the word "coated" be amended to the word -- deposited --.

Claim 26

line 6, the word "a" (second occurrence) should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

I. Claims **17-29** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for electrodepositing the catalytically active material on a metallic substrate **by** applying an electric direct voltage, on which an alternating voltage is superimposed, does not reasonably provide enablement for depositing (= an electrolessly depositing) the catalytically active material on a metallic substrate **and** applying an electric direct voltage, on which an alternating voltage is superimposed (= a post electrolytic surface treatment). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claim 1, lines 7-12, recites "depositing the catalytically active material on a metallic substrate, and applying an electric direct voltage, on which an alternating voltage is superimposed in such a way that the sign of the sum voltage of direct and alternating voltage does not change, between the substrate and the counterelectrode".

This claim limitation reads on 2 separate steps: depositing (= an electrolessly depositing) the catalytically active material on a metallic substrate **and** applying an electric direct voltage, on which an alternating voltage is superimposed (= a post electrolytic surface treatment). However, Applicants' Fig.1 shows the arrangement for carrying out the process according to the invention. It appears that the depositing and applying steps as presently claimed are carried out 1 step. Thus, the claims are not commensurate in scope with the specification.

II. Claims **17-29** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17

lines 7-8, it appears that "a metallic substrate" is further limiting the substrate recited in claim 17, line 2. However, it is unclear if it is.

line 9, it appears that "an electric direct voltage" is further limiting the voltage recited in claim 17, line 5. However, it is unclear if it is.

lines 10-11, it is unclear what is meant by "the sign of the sum voltage of direct and alternating voltage". What is the sign?

line 11, it appears that the "direct and alternating voltage" are the same as that recited in claim 17, lines 9-10, respectively. However, it is unclear if they are. If they are, then it is suggested that the word -- the -- be inserted before the word "direct".

Claim 24

line 3, it appears that the "substantially spherical platinum clusters" are further limiting the catalytically active material recited in claim 17, line 7. However, it is unclear if they are.

line 4, it appears that "a solution" is the same as the electrolyte recited in claim 17, line 4. However, it is unclear if it is.

line 6, it appears that "a modulated voltage" is the same as the electric direct voltage, in which an alternating current is superimposed recited in claim 17, lines 9-10. However, it is unclear if it is.

lines 6-7, "said direct voltage of approximately 1.3 volts" lacks antecedent basis.

lines 7-8, "said alternating voltage with a voltage swing of 0.3-1 volt" lacks antecedent basis.

Claim 25

line 3, it appears that the “substantially dendritic platinum clusters” are further limiting the catalytically active material recited in claim 17, line 7. However, it is unclear if they are.

line 4, it appears that “a solution” is the same as the electrolyte recited in claim 17, line 4. However, it is unclear if it is.

line 6, it appears that “a modulated voltage” is the same as the electric direct voltage, in which an alternating current is superimposed recited in claim 17, lines 9-10. However, it is unclear if it is.

lines 6-7, “said direct voltage of approximately 1.3 volts” lacks antecedent basis.

lines 7-8, “said alternating voltage with a voltage swing of 0.3-1 volt” lacks antecedent basis.

Claim 26

line 3, it appears that the “substantially dendritic rhodium clusters” are further limiting the catalytically active material recited in claim 17, line 7. However, it is unclear

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if they are.

line 4, it appears that "a solution" is the same as the electrolyte recited in claim 17, line 4. However, it is unclear if it is.

lines 6-7, "said direct voltage of 1.4-1.6 volts" lacks antecedent basis.

lines 8-9, "said alternating voltage (V_{ac}) with a voltage swing (V_{pp}) of 0.3-1.5 volts" lacks antecedent basis.

Claim 28

line 2, it is unclear what is meant by "formed by platinum-coated titanium".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **17-29** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-15** of copending Application No. 09/944,148 (Patent Application Publication No. US 2002/0052292 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim limitations of: (a) depositing a catalytically active material on a metallic substrate and (b) applying an electric direct voltage, on which an alternating voltage is superimposed between the substrate and a counterelectrode are common to the above. It appears that Applicants have taken these limitations and made the present independent claim narrower by incorporating claim limitations that were in dependent claims of the copending application. Thus, the claims are not patentably distinct from each other because the independent claim of the present invention recite limitations that are readable on, either alone or in combination with its dependent claims, the claims of the copending application and vice versa, wherein the claims of the present invention (the narrow claims) are encompassed by the claims of the copending application (the broad claims). Therefore, the claims would have been obvious variants over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Citations

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arlt et al. (US Patent No. 6,197,179 B1) is cited to teach a process for coating objects by means of direct current, in which process an adjustable DC voltage is pulse-modulated with an adjustable AC voltage. The material deposited is a cationic resinous coating material (col. 4, lines 36-45).

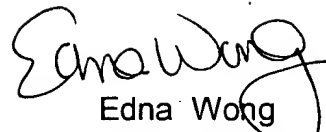
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1495.

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Edna Wong
Primary Examiner
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EW
September 4, 2003